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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
SEL 273

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on September 21, 2006

Signature Shannon Wallace

Typed or printed name Shannon Wallace

Application Number	Filed
09/934,699	August 22, 2001

First Named Inventor: Satoru Okamoto et al.

Art Unit	Examiner
2871	T. Duong

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 34,225

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Mark J. Murphy
Signature

Mark J. Murphy
Typed or printed name

312-236-8500
Telephone number

September 21, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 3 forms are submitted.

Attorney Docket SEL 273

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Satoru Okamoto et al.)
)
Serial No.: 09/934,699)
)
Filed: August 22, 2001)
)
For: Portable Electronic Device)
)
Art Unit: 2871)
)
Examiner: T. Duong)

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Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450 on
September 21 2006
(Date of Deposit)
Shannon Wallace
Name of applicant, assignee, or Registered Rep.
Shannon Wallace 9/21/06
Signature Date

Commissioner for Patents
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Alexandria, VA 22313-1450

REASONS FOR REVIEW OF FINAL REJECTION

Dear Sir:

Applicants request a Pre-Appeal Brief Review of the Examiner's rejections in the Final Rejection of May 12, 2006. The rejections are in clear error as:

(1) the references do not disclose or suggest at least one of the claimed features of the present application, i.e. that the first display panel is one of a liquid crystal display panel and an EL display panel *and* the second display panel is the other one of the liquid crystal display panel and the EL display panel.; and

(2) the combination of references and the Examiner's standard for combining the references are improper.

While each of these errors is present in all of the rejections in the Final Rejection, Applicants will us the Examiner's primary rejection of independent Claims 1 and 2 to illustrate the errors in the Final Rejection for which review is requested.

In the Final Rejection, the Examiner rejects Claims 1 and 2 under 35 U.S.C. §103(a) as being

unpatentable over Priestman et al. (US 6,812,954) in view of Nakai et al. (US 6,072,454) and Yamazaki (US 6,037,635). As explained below, this rejection is clearly erroneous.

A. Examiner's Basis For Rejection

In the Final Rejection, the Examiner contends that Priestman "discloses a portable electronic device that is basically the same as that recited in claims 1, 2, 34 and 35, except that Priestman does not disclose that the second display device and the first display device are active matrix displays." The Examiner then cites Nakai as allegedly showing "that main liquid crystal display devices are of active matrix type excelling in display performance," and Yamazaki as allegedly showing "a portable electronic device comprising a liquid crystal display device, wherein the liquid crystal display device may be an active matrix type EL display." The Examiner then argues that:

"it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the portable electronic device of Priestman by employing an EL display of Yamazaki for the first display device and an active matrix display of Nakai for the second display device so as to obtain a downsized and lightened device having a high image quality and high reliability without consuming much power (Nakai, col. 4, lines 1-5 and Yamazaki col. 6, lines 51-59)."

The Examiner further contends that:

"[t]hus, there's no reason why one having ordinary skill in the art at the time the invention [sic] cannot modify the portable electronic device of Priestman by employing the active matrix LCD of Nakai and the active matrix EL display of Yamazaki for the first and second liquid crystal display panels of Priestman in order to obtain an excellent display performance (Nakai, col. 2, lines 56-60) and also a downsized and lightened device with a low power consumption (Yamazaki, col. 6, lines 51-59)."

As explained in detail, the rejection is clearly in error as the references fail to disclose or suggest the claimed invention, the combination of references is improper, and the Examiner is applying an improper standard for combining references.

B. Even If Properly Combinable, None of The References Disclose Or Suggest All of The Claimed Elements

Independent Claims 1 and 2 recite that the first display panel is one of a liquid crystal display

panel and an EL display panel *and* the second display panel is the other one of the liquid crystal display panel and the EL display panel. Hence, one is a liquid crystal display panel and the other is an EL display panel.

In contrast, while Priestman discloses a first display device and a second display device in a portable electronic device, the reference does not disclose or suggest that that one of the display panels is a liquid crystal display panel *and* that the other display panel is an EL display panel. In fact, the reference provides no disclosure or suggestion that the displays can be different.

Instead, Priestman discloses a portable electronic device in which the "lower half 204 comprises an LCD video display 226 essentially identical to the video display 220 described as contained in the upper half 202..." Col. 8, ln. 38-42 (emphasis added). Clearly, Priestman is directed to having the two displays that are essentially identical (LCD displays), and there is no suggestion or motivation in Priestman (and the Examiner has cited no such suggestion or motivation from Priestman) to modify the portable electronic device in Priestman to have two different displays.

Further, Nakai does not disclose or suggest that one display panel is a liquid crystal display panel *and* the second display panel is an EL display panel. In fact, Nakai does not even suggest having two display panels, much less that the two display panels could be different. Hence, even if it were proper to combine Priestman and Nakai, such a combination would at best still have both the first display panel and the second display panel essentially identical and would not disclose or suggest the claimed invention.

Yamazaki also does not disclose or suggest that one display panel is a liquid crystal display panel and the other display panel is an EL display panel. In fact, Yamazaki does not suggest having two different display panels. Hence, since Priestman also does not disclose or suggest this claimed feature, even if it were proper to combine Priestman and Yamazaki (and even Nakai), such a

combination would still at best have both the first display device and the second display device essentially identical and would not disclose or suggest the claimed invention.

Hence, none of the references provide any teaching or suggestion that the two display panels are different. Therefore, even if these references are properly combinable (which Applicants do not admit), the combination still fails to disclose or suggest the device of Claims 1 and 2 of the present application having one display panel a liquid crystal display panel and the other display panel an EL display panel. Accordingly, the rejection is clearly erroneous as one of the elements of the claims is clearly missing from the references and the rejection. Therefore, the rejection should be reversed or withdrawn.

C. The Combination of References Is Improper And Is Based on an Improper Standard

Further, it is not proper to combine Priestman, Nakai and Yamazaki to arrive at the claimed invention. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fitch*, 23 USPQ2d 1780, 1783-1784 (Fed. Cir. 1992). In this case, none of the references provide any suggestion for having one display panel as a liquid crystal display panel and the other display panel as an EL display panel. While the references may discuss liquid crystal display panels and EL display panels, none of the references provide any suggestion to have a display device with two different display panels, one a liquid crystal display panel and the other an EL display panel. Hence, the combination of references to arrive at the claimed invention is improper as there is no suggestion or motivation to combine the references in the manner of Claims 1 and 2.

Further, the Examiner's standard for combining the references is improper. As the Federal Circuit stated in *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000),

"Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of

each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." (citations omitted).

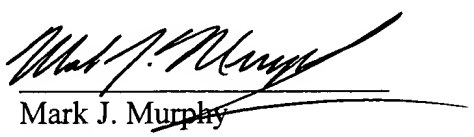
The teaching or suggestion must be in the form "that one of ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention." *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Int., 1993). To combine references where there is an absence of an objective teaching or suggestion to combine the references is to fall victim to improper hindsight reconstruction. *In re Fine*, 5 USPQ2d 1596, 1599-1600 (Fed. Cir. 1988).

Here, the Examiner's standard that "there's no reason why one of ordinary skill in the art at the time the invention cannot modify" Priestman to arrive at the claimed invention does not follow the standard under the law and is clearly improper. Instead, this appears to be a clear example of improper hindsight reconstruction based on the claims of the present application.

D. Conclusion

Therefore, the rejections in the Final Rejection are clearly in error as the combination of references is improper and is based on an improper standard, and even if combined, the references are missing a key claimed element. Accordingly, it is respectfully requested that the rejection be reversed or withdrawn, and a new action issued or the application allowed.

Respectfully submitted,



Mark J. Murphy
Registration No. 34,225

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.
200 West Adams Street, Suite 2850
Chicago, Illinois 60606
(312) 236-8500; Customer no. 26568